REMARKS

This amendment is responsive to the Office Action mailed June 22, 2009. Claims 1-10, 12-30, and 32-38 are pending in the application. Claims 1, 12, 22, and 30 have been amended. Claim 39 has been canceled in view of the amendment made to Claim 30.

In response to a telephone restriction requirement made on June 16, 2009, applicants provisionally elected Claims 12-29 for further examination. This election was made with traverse, for reasons discussed further below. Non-elected Claims 1-10, 30, and 32-38 currently stand withdrawn.

The Office Action rejected Claims 12-21 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Furthermore, Claims 12, 21, and 22 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bernard et al., U.S. Patent No. 5,918,213 (hereinafter "Bernard"), in view of Kinjo, U.S. Patent Application Publication No. 2003/0063575 (hereinafter "Kinjo"). Claims 13, 14, 16-20, and 29 were rejected as allegedly being unpatentable over Bernard and Kinjo, and further in view of Siegel et al., U.S. Patent Application Publication No. 2002/0082931 (hereinafter "Siegel"). Claim 15 was rejected as being allegedly unpatentable over Bernard and Kinjo, and further in view of Fitzsimmons, Jr., U.S. Patent Application Publication No. 2002/0068991 (hereinafter "Fitzsimmons").

Reconsideration and allowance of the application is requested in view of the claim amendments presented herewith and the following remarks.

Examiner Interview

Prior to discussing the restriction requirement and the patentability of the claims, applicants thank Examiner Serrao for the time and courtesy he extended in a telephone interview with the undersigned counsel on September 8, 2009. The interview initially addressed the rejection of Claims 12-21 under Section 101. A tentative agreement was reached that amending Claim 12 to recite "wherein each of the subsystems of the server operate using a processor in communication with a memory unit of the server," would overcome the Section 101 rejection.

The interview thereafter focused primarily on Claim 12 and the features of the claim that distinguish over Bernard and Kinjo. Amendments to Claim 12 were discussed and are presented herewith for further consideration. Similar amendments were made to the other independent claims, Claims 1, 22, and 30.

Restriction Requirement and Election of Claims

As per request of the Office Action, applicants hereby affirm the provisional election of Claims 12-29 with traverse. For at least the reasons discussed below, applicants request withdrawal of the restriction of Claims 1 and 30, and their dependent claims.

The following table provides a comparison of Claims 1 and 12, as amended. In particular, attention is drawn to the correspondence of subject matter recited in Claims 1 and 12 (italics added to Claim 12 solely for purposes of comparison).

Claim 1	Claim 12
A computer-implemented method for communicating information regarding a selected item to a user present at a location of a first retail entity from a second retail entity different from the first retail entity, wherein the selected item is available for purchase at the second retail entity, the method comprising: while the user remains present at the location of the first retail entity, one or more processing components of a computer system operated by the second retail entity:	A computer system for communicating information regarding a selected item to a user present at a location of a first retail entity, wherein the system comprises a server operated by a second retail entity that is different than the first retail entity and the selected item is available for purchase at the second retail entity, the server being in communication with an imaging device of the user that is configured to capture an image of identifying data associated with the selected item, the server comprising:
receiving an image from an imaging device of the user, wherein the image contains multiple instances of identifying data associated with the selected item;	a subsystem configured to *receive an image from the imaging device of the user, wherein the image contains multiple instances of identifying data associated with the selected item;*
for each of the multiple instances of identifying data, extracting the identifying data from the image using a data recognition procedure that produces an output;	a subsystem configured to *extract the identifying data from each of the multiple instances in the image using a data recognition procedure that operates on an instance of the identifying data and produces an output;*

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comparing the output of each of the data recognition procedures to corroborate the identification of the selected item that is obtained from each instance of the identifying data;	a subsystem configured to *compare the output of each of the data recognition procedures to corroborate the identification of the selected item that is obtained from each instance of the identifying data;*
using the corroborated identifying data to obtain item information associated with the selected item;	a subsystem configured to *use the corroborated identifying data to obtain item information associated with the selected item,* wherein the item information is obtained from at least one resource;
communicating the item information from the second retail entity to the imaging device of the user; and	a subsystem configured to *communicate the item information directly to the imaging device of the user while the user remains present at the location of the first retail entity*; and
storing at least one of the instances of identifying data as profile information in a database associated with the user, wherein the profile information is used to anticipate the user's purchasing interests and provide one or more targeted offers to the user to purchase an item based on the user's anticipated purchasing interests.	a subsystem with a storage database configured to *store at least one of the instances of identifying data as profile information associated with the user, wherein the profile information is used to anticipate the user's purchasing interests and provide one or more targeted offers to the user to purchase an item based on the user's anticipated purchasing interests,*
	wherein each of the subsystems of the server operate using a processor in communication with a memory of the server.

The Office Action indicated that Claims 1 and 12 were related as "combination and subcombination." In view of the foregoing comparison however, it is unclear how Claims 1 and 12 represent a combination and subcombination that are distinct within the meaning of 35 U.S.C. § 121. More specifically, applicants submit that the Office Action has not sufficiently shown that (1) the alleged combination, as claimed, does not require the particulars of the subcombination, as claimed, for patentability, and (2) that the alleged subcombination has utility by itself or in other combinations (see MPEP § 806.05(c)).

The Office Action (page 3) stated that Group I "relates to electronic shopping (e.g., remote ordering)," while Group II "has separate utility such as market analysis, demand forecasting or surveying." However, from inspection of Claim 1, it is evident that the claims of Group I require use of profile information "to anticipate the user's purchasing interests and

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provide one or more targeted offers to the user to purchase an item based on the user's anticipated purchasing interests," as recited in the claims of Group II. Similarly, from inspection of Claim 12, it is evident that the claims of Group II relate to electronic shopping as do the claims of Group I. For at least the foregoing reasons, applicants respectfully submit that the requirements for restriction have not been met and, therefore, applicants request withdrawal of the restriction between the claims of Group I (Claims 1-10 and 36-38) and the claims of Group II (Claims 12-29).

Applicants also respectfully request withdrawal of the restriction of the claims of Group III (Claims 30 and 32-35). As with the comparison of Claims 1 and 12 above, a comparison of Claim 30 with Claim 12 demonstrates the correspondence of subject matter that is claimed in the two groups. Claim 30 is directed to an integrated portable apparatus that includes, inter alia, "an input device configured to capture an image that contains multiple instances of identifying data associated with the selected item" and "a processing unit . . . for executing the program instructions that process the image by:

> extracting each of the multiple instances of identifying data from the image using a data recognition procedure that produces an output;
> outputting the identifying data on the output device to allow the user to review and edit or modify the identifying data before the identifying data is communicated to a server operated by the second retail entity;
> communicating the identifying data to the server operated by the second retail entity, wherein the selected item is available for purchase from the second retail entity;
> storing at least one of the instances of identifying data as profile information in a database associated with the user, wherein the profile information is used to anticipate the user's purchasing interests and provide one or more targeted offers to the user to purchase an item based on the user's anticipated purchasing interests;
> receiving, from the server of the second retail entity, item information for the selected item identified by the identifying data obtained from the image; and
> outputting the item information on the output device, wherein the output device communicates the item information to a user while the user remains at the location of the first retail entity."

The Office Action (page 3) states that Group III "has separate utility such as client/server," but it remains unclear how this allegation meets the requirement set forth in MPEP § 806.05(c). From inspection of Claim 30, it is evident that the claims of Group III relate to electronic shopping as do the claims of Group I and II, and furthermore, the claims of Group III include the use of "profile information. . . to anticipate the user's purchasing interests and provide one or more targeted offers to the user to purchase an item based on the user's anticipated purchasing interests." For at least the foregoing reasons, applicants respectfully request withdrawal of the restriction between the claims of Group III (Claims 30 and 32-35) and the claims of Group I (Claims 1-10 and 36-38) and Group II (Claims 12-29).

Alternatively, in view of the amendments and arguments presented herewith, applicants request rejoinder of Claims 1 and 30, and their dependent claims.

<u>Patentability of the Claims</u>

<u>Claims 12-21 Recite Patent-Eligible Subject Matter</u>

The Office Action alleged that Claims 12-21 do not meet the requirements of 35 U.S.C. § 101 for reciting statutory subject matter. While applicants respectfully disagree, applicants desire to advance the prosecution of the application and therefore have amended Claim 12 in line with the suggestion made by the Examiner in the Office Action.

Specifically, applicants have amended Claim 12 to recite "a computer system" that "comprises a server," and as claimed, the server comprises various subsystems, "wherein each of the subsystems of the server operate using a processor in communication with a memory unit of the server."

Applicants respectfully submit that amended Claim 12 recites statutory subject matter and therefore meets the requirements of Section 101, and by dependence on Claim 12, Claims 13-21 also recite statutory subject matter.

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<u>Independent Claim 12 is Patentable Over Bernard and Kinjo</u>

The Office Action rejected Claim 12 as allegedly being unpatentable over Bernard in view of Kinjo. Applicants respectfully traverse this rejection.

Claim 12 is directed to system for communicating information regarding a selected item to a user present at a location of a first retail entity. The server as claimed comprises various subsystems, including subsystems configured to:

- "receive an image from the imaging device of the user, wherein the image contains multiple instances of *identifying data associated with the selected item*;"

- "extract the identifying data. . .;"

- "corroborate *the identification of the selected item* that is obtained from each instance of the identifying data;" and

- "store at least one of the *instances of identifying data* as profile information associated with the user, wherein the profile information is used *to anticipate the user's purchasing interests and provide one or more targeted offers* to the user *to purchase an item based on the user's anticipated purchasing interests*." (Emphasis added solely for purposes of discussion.)

In regard to the last element of Claim 12, the Office Action (page 11) cited particularly to Col. 10, lines 48-60, and Col. 51, lines 29-41, of Bernard.

Col. 10, lines 48-60 of Bernard teaches the following:

> In one embodiment, if the purchaser is not a member, the purchaser is still permitted to browse the available product listings, listen to or view product descriptions and sample product offerings. The non-member purchaser can even purchase products. However, because a non-member does not have a membership profile, the non-member will speak to a sales representative to complete the sale. At this time, the sales representative obtains **payment and delivery information** from the purchaser to complete the sale. If the purchaser desires, **this information can be entered into a membership profile** for that purchaser, allowing the purchaser to purchase products in the future without having to speak to a sales representative. (Emphasis added for discussion purposes.)

According to Bernard, a member is someone who has previously provided "payment and delivery information" that is stored in a membership profile. The benefit of having such payment and delivery information in a membership profile is that the next time the person wishes to purchase products, he or she will not have to speak to a sales representative. Instead, presumably, the payment and delivery information is automatically obtained from the membership profile and the sale is completed.

Notably, the disclosure in this paragraph does <u>not</u> teach or suggest the element of Claim 12 in which "at least one of the instances of identifying data" is stored as profile information associated with the user. As per Claim 12, the "instances of identifying data" are associated with the selected item and provide for identification of the selected item.

In Bernard, the "payment and delivery information" is purchaser-related information that is not "associated with the selected item." The payment and delivery information is not item specific; instead, it simply allows a purchaser to purchase any item in the future without having to speak to a sales representative. Consequently, storing "payment and delivery information" as per Bernard cannot reasonably be read as teaching or suggesting storing "at least one of the instances of identifying data," which is explicitly "associated with the selected item" and therefore specific to the selected item, as per Claim 12 of the present application.

In addition, there is a significant difference between Bernard's use of general purchaser-related "payment and delivery information" on the one hand to complete a sale, and the present application's use of item-specific "instances of identifying data," on the other hand to anticipate the user's purchasing interests and provide one or more targeted offers to the user to purchase an item based on the user's anticipated purchasing interests.

Col. 51, lines 29-41, of Bernard reads as follows:

> In one embodiment promotional items are offered to a customer 182 based on his or her calling and purchasing history. For example, in one embodiment, the automated product purchasing system review calling and purchasing statistics maintained for a shopper 182. Statistics can be maintained by VRU 104, interactive transaction database 112, or even by

reporting database 438. If these statistics indicate that the shopper is a particularly good customer of the automated product purchasing system, interface unit 104 may offer a promotional or special item to that shopper 182. For example, where shopper 182 is a frequent purchaser, interface unit 104 may inform him or her that upon the next purchase, he or she will receive a bonus CD.

In this passage, Bernard refers to a customer's "calling and purchasing history" and "purchasing statistics," and suggests that such information may "indicate that the shopper is a particularly good customer of the automated product purchasing system." Such customer information is not used in Bernard to anticipate the customer's purchasing interests. The information is instead analyzed to determine if the customer is a "particularly good customer."

According to Bernard, a particularly good customer (i.e., a "frequent purchaser") may be provided with a reward, such as a promotional or special item. While Bernard may provide rewards to good customers for making frequent purchases, such as a "bonus CD" (Col. 51, line 41) or a "promotional T-shirt" (Col. 51, line 49), this disclosure does not teach or suggest using profile information "*to anticipate the user's purchasing interests and provide one or more targeted offers to the user to purchase an item based on the user's anticipated purchasing interests*," as claimed in Claim 12.

Furthermore, a customer's "calling and purchasing history" and "purchasing statistics" are reflective of the customer. This information does not constitute "instances of identifying data" which, according to Claim 12, are explicitly "associated with the selected item" and further, are "used to anticipate the user's purchasing interests" and to "provide one or more targeted offers to the user to purchase an item based on the user's anticipated purchasing interests."

In view of the above, applicants respectfully submit that Bernard cannot reasonably be read as teaching or suggesting the elements of Claim 12, including "a subsystem with a storage database configured to store at least one of the instances of identifying data or the item information as profile information associated with the user, wherein the profile information is used to anticipate the user's purchasing interests and provide one or more targeted offers to the

user." Applicants have also considered the disclosure of Kinjo and find that the above-noted deficiencies of Bernard are not overcome. Therefore, it is submitted that Claim 12 is patentable over Bernard and Kinjo.

Dependent Claims 13-21

Dependent Claims 13-21 depend either directly or indirectly from independent Claim 12. As discussed above, applicants submit there is no combination of Bernard and Kinjo that teaches or suggests all of the elements of independent Claim 12. Claims 13-21 also include a number of recitations that are not taught or suggested by Bernard, Kinjo, or Siegel, particularly when the recitations are considered in combination with the recitations of Claim 12 from which these claims depend. For at least the above-mentioned reasons, Claims 13-21 are likewise in allowable condition. Withdrawal of the rejections of Claims 13-21 is requested.

Independent Claim 22

Amended Claim 22 recites elements similar to those set forth in amended Claim 12. Accordingly, for at least reasons similar to those discussed above with respect to Claim 12, applicants submit that Bernard and Kinjo, whether considered alone or combined, fail to teach or suggest all of the elements of Claim 22. In particular, Bernard and Kinjo fail to teach the recited "computer-executable component [that] is executed by a server of the second retail entity" that "stor[es] at least one of the instances of identifying data as profile information in a database associated with the user, wherein the profile information is used to anticipate the user's purchasing interests and provide one or more targeted offers to the user to purchase an item based on the user's anticipated purchasing interests," as claimed.

For at least these reasons, the rejection of Claim 22 should be withdrawn.

Dependent Claims 23-29

Claims 23-29 are dependent on Claim 22 and, thus, are allowable for at least the reasons discussed above in connection with Claim 22. Claims 23-29 also include a number of recitations not disclosed, taught, or suggested by Bernard, Kinjo, or Siegel, particularly when the recitations

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are considered in combination with the recitations of Claim 22 from which these claims depend. Claims 23-29 are therefore submitted as being patentable over Bernard, Kinjo, and Siegel.

Independent Claim 1

As discussed earlier, Claim 1 currently stands withdrawn from examination. However, applicants submit that the restriction of Claim 1 is improper and therefore provides the following arguments for the patentability of Claim 1 and its dependent claims.

Claim 1 is directed to a method for one or more processing components of a computer system operated by a second retail entity to communicate information regarding a selected item to a user present at the location of a first retail entity. As indicated in Claim 1, the second retail entity is different from the first retail entity.

The method includes receiving an image from an imaging device of the user, wherein the image contains multiple instances of identifying data associated with the selected item. For each of the multiple instances of identifying data, the method of Claim 1 further requires extracting the identifying information from the image using a data recognition procedure that produces an output and comparing the output of each of the data recognition procedures to corroborate the identification of the selected item that is obtained from each instance of the identifying data. The corroborated identifying data is thereafter used to obtain item information associated with the selected item and the item information is communicated from the second retail entity to the imaging device of the user.

Claim 1, as amended, further recites "storing at least one of the instances of identifying data as profile information in a database associated with the user, wherein the profile information is used to anticipate the user's purchasing interests and provide one or more targeted offers to the user to purchase an item based on the user's anticipated purchasing interests." For reasons similar to those discussed above with respect to Claim 12, applicants submit that this element in combination with the other elements of Claim 1 is not taught or suggested by Bernard and/or Kinjo, nor does Siegel cure the deficiency of disclosure.

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Amended Claim 1 is therefore patentably distinguished over the cited references. Claim 1 should be allowed.

Dependent Claims 2 and 4-10

Dependent Claims 2 and 4-10 ultimately depend from independent Claim 1. Therefore, Claims 2 and 4-10 are likewise considered to be in allowable condition over Siegel and Kinjo for at least the reasons discussed above in connection with Claim 1. Claims 2 and 4-10 are also allowable for the additional subject matter they recite.

Dependent Claim 3

As with Claims 2 and 4-10, applicants submit that Claim 3 is patentable over Bernard, Kinjo, and Siegel for at least its dependence on Claim 1. Additionally, applicants have considered the disclosure of Fitzsimmons with respect to Claim 3 and submit that Fitzsimmons does not overcome the deficiencies of disclosure in Bernard, Kinjo, and Siegel as discussed with respect to Claim 1.

Dependent Claims 36-38

Claim 36 is directed to the method of Claim 1 and further comprises "judging a quality of the output of each of the data recognition procedures and using the best identifying data to obtain the item information." While the present Office Action did not discuss Claims 36-38 as they were withdrawn from examination, the previous Office Action cited Kinjo at paragraph [0125] as allegedly teaching this feature. However, applicants respectfully disagree.

At paragraph [0125], Kinjo describes a process of comparing similarities of a photographed article with image data of the article. "[T]he identifying process is completed by selecting the data with the greatest degree of similarity above a predetermined value." At best, the process described by Kinjo represents a single data recognition procedure in which image data of the article is identified based on which image data has the greatest similarity with the photographed article. Greater or lesser similarity does not reflect the quality of the comparison process, but rather is a result of comparing different images with the photographed article. Kinjo

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does not describe judging a quality of the output of each of the data recognition procedures and using the best identifying data to obtain the item information, as claimed in Claim 36.

Claim 37 further comprises "polling the user to determine the correct identifying data for the selected item if the output of the data recognition procedures results in conflicting identifying data." The previous Office Action cited Kinjo at paragraph [0127] as allegedly teaching this feature. However, applicants respectfully disagree. At paragraph [0127] Kinjo describes displaying multiple images of potential articles to be ordered and allowing the user to designate which image represents the article to be ordered. The images, however, are not "identifying data," but rather are images of the article itself.

Claim 38 recites "wherein if the data recognition procedures output conflicting identifying data, the method further comprises obtaining item information for all of the items identified by the output of the data recognition procedures." The previous Office Action cited Kinjo at paragraph [0124] but this passage of Kinjo does not discuss multiple data recognition procedures that output conflicting identifying data, nor does it describe obtaining item information for all of the items identified by the output of the data recognition procedures in such circumstances.

Applicants have considered the disclosures of Bernard, Kinjo, Siegel, and Fitzsimmons and submit that the cited art does not teach or suggest the features of Claims 36-38.

Independent Claim 30

As with Claim 1, Claim 30 currently stands withdrawn from examination. Nevertheless, applicants believe that the restriction of Claim 30 is improper and therefore provides the following arguments for the patentability of Claim 30 and its dependent claims.

Claim 30 is directed to an "integrated portable apparatus for obtaining item information for a selected item available for purchase at a location of a first retail entity." The apparatus comprises, among other things, "an input device configured to capture an image that contains multiple instances of identifying data associated with the selected item," and "a processing unit

communicatively coupled to the input device, the output device, and the storage medium, for executing the program instructions that process the image." The image processing includes "extracting each of the multiple instances of identifying data from the image using a data recognition procedure that produces an output" and "outputting the identifying data on the output device to allow the user to review and edit or modify the identifying data before the identifying data is communicated to a server operated by the second retail entity." In Kinjo, the image of an article obtained by the portable apparatus is immediately uploaded to a server for processing. The user does not have any input into the process until after the image is uploaded and the image is processed by the server. Neither Bernard nor Kinjo discloses all the features of Claim 30, and even if combined, the references do not render obvious the apparatus claimed in Claim 30.

Furthermore, Claim 30 has been amended to recite "storing at least one of the instances of identifying data as profile information in a database associated with the user, wherein the profile information is used to anticipate the user's purchasing interests and provide one or more targeted offers to the user to purchase an item based on the user's anticipated purchasing interests." For at least reasons similar to those discussed above with respect to Claim 12, applicants submit that this feature in combination with the other features of Claim 30 is not taught or suggested by the cited art. Applicants therefore submit that Claim 30 is in patentable condition.

Dependent Claims 31-35

Dependent Claims 31-35 depend from independent Claim 30. Claims 31-35 are patentable over Bernard, Kinjo, and Siegel, both for their dependence on Claim 30 and for the additional subject matter they recite.

CONCLUSION

In view of the foregoing amendments and remarks, applicants submit that all of the pending claims in the present application are in condition for allowance. Reconsideration of the application and allowance of the claims is requested. Should the Examiner have any questions or

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comments concerning this application, the Examiner is invited to contact the undersigned counsel at the telephone number provided below.

Respectfully submitted,

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